REMARKS

Federal Circuit has explicitly addressed § 103 and followed the approach this Court set forth for applying that provision. Section 103 provides, in pertinent part:

> A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary sill in the art to which said subject matter pertains.

35 U.S.C. § 103(a).

The Supreme Court in *Graham* held that:

> While the ultimate questions of patent validity is one of law, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy.

Graham v. John Deere, Co., 383 U.S. 1 (1966).

Thus, under *Graham*, the obviousness inquiry is highly fact specific, and requires an examination of the following: (1) the scope and content of the prior art; (2) the differences between the patented invention and what already existed in the prior art; (3) the ordinary level of skill of people working in the field; and (4) other objective evidence which may suggest that the invention would not have been obvious. The Court also warned lower courts to "guard against slipping into use of hindsight,"...and to resist the temptation to read into the prior art the teachings of the invention in issue." 383 U.S. at 36. *See also Ashland Oil, Co. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 291 (Fed. Cir. 1985), *cert. denied* 475 U.S. 1017 (1986).

The rejections of pending claims 14-18 and 28 as unpatentable under 35 U.S.C. § 103(a) are respectfully traversed, since a *prima facie* case of obviousness has not been made by the Examiner. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or in

combination, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (See M.P.E.P. § 2143 (8th Ed. 2001)). Applicant submits that these requirements have not been met for at least the following reasons:

1. The references in combination do not teach or suggest each and every element of the recited claims.

The Betts patent discloses an apparatus for detecting the presence of insects in particulate matter having a vibration receiving structure physically contacting a piezoelectric transducer. The piezoelectric transducer generates electrical signals in response to mechanical forces applied thereto. The presently claimed invention has a small needle/probe attached. Batt discloses a probe, the dimension of the type is extremely big (bigger or equal to 3/8" OD and longer than 3 feet) as compared to the presently claimed detection member. The Batts' probe is for inserting into grain (commodities), it is not suitable to insert into building structure without creating extensive damage to building structure.

Additionally, the Betts' apparatus is configured to transfer insect sound in commodities (structure borne sound) to a large receiving probe (structure borne sound) to a piezoelectric transducer (structure borne sound). The presently claimed apparatus involves (structure borne sound) sound transfer is termite sound in building structure (structure borne sound) to receiving probe (structure borne sound) to a stethoscope membrane (structure borne sound) to an electric microphone (air borne sound).

Hickling's design was not for building structure termite detection. It was for commodities insect quality control. Hickling's sensor does not include a probe. His design includes removing of background noise by placement of multiple sensors in a big metal container box that provides noise and vibration isolation. The Hickling disclosure is unrelated to the presently claimed apparatus. His design includes removing of background noise by placement of multiple sensors in a big metal container box that provides noise and vibration isolation. The Hickling disclosure is unrelated to the presently claimed apparatus.

2. There is no motivation to combine the references in a manner resulting in the claimed invention.

The federal Circuit's so-called "teaching-suggestion-motivation" standard for obviousness is fully consistent with *Graham* and its progeny. Under that standard, there must be some motivation or suggestion to combine specific prior art in such a way as to arrive at the particular combination disclosed in the patent at issue. *See, e.g., Ecolochem, Inc. v. Southern California Edison Co.,* 227 F.3d 1361, 1372 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 974 (2001); *Ashland Oil*, 776 F.2d at 293. Importantly, as *Graham* instructed, the injection of hindsight in evaluating obviousness must be avoided; the requirement of a suggestion to combine prior art prevents hindsight reconstruction by accused infringers who try to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. *See, e.g., Yamanouchi Pharmaceutical Co., Ltd, v. Danbury Pharmacal, Inc.,* 231 F.3d 1339, 1343 (Fed. Cir. 2000) ("the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness."); *Ecolochem,* 227 F.3d at 137-72 ("Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight.") (citations omitted); *Grain Processing Corp. v. American Maize-Products Co.,* 840 F.2d 902, 907 (Fed. Cir. 1988). Both of the cited references relate to apparatus configured for detection of termites in commodities the design of the apparatus is unrelated to present technical problems.

3. A reasonable expectation of success does not exist in the combination of the cited art.

As the Court of Appeals for the Federal Circuit has stated multiple times before, an invention also may not be rendered obvious unless the prior art is sufficiently enabling. *Motorola, Inc. v. Interdigital Technology Corp.,* 121 F.3d 1461, 1471 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produckter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989). Neither of the cited documents include a detector configured to be inserted into a potential infestation site without damaging the structure, such as a hypodermic needle. Consequently, there would not be a reasonable expectation of success in combining these references.

Applicant respectfully suggests that the pending claims are in condition for allowance.

Respectfully Submitted,

BUTLER, SNOW, O'MARA,
STEVENS & CANNADA

Date: June 6, 2006

By: _____

Susan B. Fentress
Registration No. 31,327
6075 Poplar Avenue, Suite 500
Memphis, TN 38187
Telephone: 901-680-7319

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, on 6/6/06, in a package addressed to: Mail Stop: AMENDMENT Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

_____
Terri Warner

Memphis 219648v.1